



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,346	01/30/2002	Laurent Chassott	1925	1163

7590

09/26/2003

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EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,346

Applicant(s)

CHASSOTT ET AL.

Examiner

Eisa B Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 12-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 10-18 are pending in this application.

### **DETAILED ACTION**

1 This action is responsive to the amendment filed on January 30, 2002.

2 The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-9 been renumbered 10-18.

### ***Double Patenting***

3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4 Claims 10-11 and 16-17 are rejected under the judicially created doctrine of double patenting over claims 1-4 and 6-13 of U. S. Patent No. 6,500,213 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claims are drawn to the colorants for oxidative dyeing of keratin fibers based on a developer-coupler combination, characterized in that both set of claims contain similar developers when in the (US, 213 B1), the claims teach a developer of the formula (I), in which R7 is a hydroxyl group, R10 is an amino group and R5, R6, R8 and R9 are hydrogen atoms (see col. 34 and col. 35, claim 1) and wherein the claimed formula (I), R3 and R6 are amino groups and R1, R2, R4 and R5 are hydrogen atoms.

The instant claims differ from the claims of the US patent by reciting a developer compound having a formula (I), in which position 2 is occupied by hydroxyl radical and an amino radical in the biphenyl compound occupies position 5.

However, the claims of the US Patent teaches a developer compound of the formula (I), in which position 2 may occupied with a hydroxyl radical (R10) and position 5 may occupied with unsubstituted amino radical (R7) (see col. 35, lines 7-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a colorant composition because the claims of the US Patent teach a colorant composition comprising developer compound of the formula (I), in which a hydroxyl radical is occupied position 2 and the amino group is occupied position 5 in the biphenyl compound, and, thus, a person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent unexpected results.

***Claim Rejections - 35 USC § 102***

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6 Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 10-11 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Braun et al. (WO 99/59527).

Braun (WO' 527) teaches a colorant for oxidative dyeing of keratin fibers based on a developer-coupler combination, characterized in that it contains as the developer at least one biphenyl derivatives of a formula (I), which is identical to the claimed formula (I), when in the reference's formula (I), R5 is a hydrogen atom, R7 is an amino group, R10 is a hydroxyl group, R6, R8 and R9 are hydrogen atoms as claimed in claims 10-11 (see page 3, formula I) and when in the claimed formula (I), R1 is a hydrogen atom, R3 and R6 are amino groups and R2, R4 and R5 are hydrogen atoms as claimed, and wherein the biphenyl compound is presented in the amount from 0.005 to 20.0 % by weight as claimed in claim 16 (see page 26, fourth paragraph). The colorant has a pH of the range 6.8 to 11.5, which is falls within the claimed range as claimed in claim 17 (see page 31, 2<sup>nd</sup> paragraph). Braun teaches all the limitations of the instant claims. Hence, Braun anticipates the claims.

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7 Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Edward et al. (EP 0 027 679 A2).

Edward (EP' 679) teaches a compound of a formula VI which is identical to the compound of the claimed formula (Ia) as claimed in claim 18, when in the reference's formula VI, X is a hydrogen atom and Y is halogen atom (see page 1, last paragraph, and page 4, formula VI) and when in the claimed formula (I), R1 is a hydrogen, R2-R5 are hydrogen atoms and R6 is halogen atom. Edward teaches all the limitations of the instant claim. Hence, Edward anticipates the claim.

#### ***Allowable Subject Matter***

8 Claims 12-15 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach or disclose a colorant composition comprising a developer of a formula (I) in which R1 to R6 groups denote hydrogen atoms of R2 to R6 are hydrogen atoms while the fifth group denotes one of the claimed groups.

#### ***Conclusion***

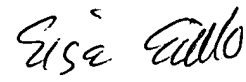
The remaining references listed on forms 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Eisa Elhilo  
Patent Examiner  
Art Unit 1751

September 15, 2003.